

## REMARKS

Claims 1-41 and 50-57 were pending in this application, of which claims 1-15, 36-41, and 50-53 are withdrawn. Claims 16, 25, 32, and 33 have been amended. Claims 30 and 31 have been cancelled. Thus, claims 1-29, 32-41, and 50-57 are now pending. Reconsideration of the pending claims is respectfully requested.

### **Rejections under 35 U.S.C. § 103**

Claims 16-18, 25, 27, and 30-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,146,273 to Olsen in view of U.S. Pat. No. 6,012,982 to Piechowiak et al. (“Piechowiak”).<sup>\*</sup> Applicant respectfully traverses this rejection, because the teachings of Olsen and Piechowiak cannot be combined in the manner suggested by the Office Action to achieve the claimed invention. As such, the Office Action has failed to establish a *prima facie* case of obviousness.

In particular, independent claim 16 and 25 recite, “said pay table being continuously displayed as said progressive awards are being updated.” Addressing this limitation, the Office Action asserts that Olsen teaches the “update [of] stored weighted payable payout amounts that are configurable for display on each gaming machine.” Office Action, p. 6, lines 9-13. However, the Office Action concedes that “Olsen does not appear to teach update the payout amounts of the payable of each gaming machine based on portions of a wager input from other gaming machines as claimed.” Office Action, p. 5, lines 16-17. Thus, to cure this deficiency, the Office Action asserts that Piechowiak teaches a plurality of gaming machines in communication with a feature controller that modifies the payout criteria of an award pay table displayed on each gaming machine. *See* Office Action, p. 5, line 26-p. 6, line 2; p. 6, lines 13-18. Specifically, the Office Action concludes:

Piechowiak provides an incentive to combine its payable amount update or modification and display features with the payable update features disclosed by Olsen to achieve continuous display of updated or modified pay table amounts during game play on each gaming machine because one having ordinary skill in the art would have known to display the updated or modified payouts on the disclosed game machines display in order

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<sup>\*</sup> Applicant notes that the Office Action states that claims 16-18, 25, 27, and 30-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,146,273 issued to Olsen. Based on the remaining sections of the Office Action, this is assumed to be a typographical error and that the claims are rejected under 35 U.S.C. § 103(a) based on Olsen in view of Piechowiak. For example, at p. 5, lines 16-18, the Office Action cites a deficiency in Olsen that it attempts to cure by applying Piechowiak.

to inform players of payable amounts for given outcomes for game play, which is a well known requirement in the gamin [sic] industry.

Contrary to the assertions in the Office Action, the weighted payout table of Olsen is not “configurable for display.” In general, the system taught by Olsen enters a bonus mode time period when fixed amounts from wagers received from gaming machines meets a randomly selected threshold value. *See* Olsen, col. 3, lines 54-62. During this bonus mode time, “each bonus jackpot during the bonus mode time is randomly, in time and through play, given to one of the eligible machines.” Olsen, col. 15, lines 60-62 (emphasis added). Olsen emphasizes that “[w]hat that machine is and when the award will be given is indeterminent [sic] and random.” Olsen, col. 15, lines 62-63. In particular, the system of Olsen counts wagers from a set of gaming machines and pays out a bonus jackpot to the gaming machine that receives a wager that causes the count to reach a randomly selected award trigger 520. *See* Olsen, col. 14, line 37-col. 15, line 6. Olsen explains that “eligible players at the gaming machines cannot predict when and who will be awarded a bonus award.” Olsen, col. 16, lines 51-53. Furthermore, Olsen teaches that the weighted payout table 294 is used by a random payout selector 292 to randomly select an amount for the jackpot bonus. *See* Olsen, col. 16, line 65-col. 17, line 2.

In view of the **random** manner in which the bonus award period, payout time, payout recipient, and payout amount are determined, the players in Olsen are not supposed to receive information regarding the actual timing and amount of the payout until the jackpot bonus is actually awarded. Indeed, Olsen discloses that an indicator 320 is activated to inform a player of the payout amount only **after** the player has won. *See* Olsen, col. 16, line 65-col. 17, line 24; col. 17, lines 52-55. As Olsen explains, excitement and incentive are generated when the player only knows that his chances for winning a jackpot bonus are increased by playing as fast as each game can be played. *See* Olsen, col. 16, lines 11-19. In one aspect, the unknown details regarding the time and amount of the payout would appear to generate excitement and curiosity and encourage players to continue playing to find out the time and amount of the payout. Thus, to preserve the excitement associated with these **mystery** bonus jackpots, Olsen actually **teaches away** from displaying any payout-related information, such as the weighted payout table, to the players during the bonus mode time. Accordingly, the weighted payout table of Olsen is not “configurable for display” as asserted by the Office Action.

Thus, although Piechowiak may teach updating and displaying a pay table, these teachings cannot be combined with Olsen’s system, because such a modification to Olsen’s

system would render it unsatisfactory for its intended purpose and would change its principle of operation. As just described, displaying information regarding the bonus jackpot amounts to players of Olsen's system as suggested by the Office Action would be contrary to the object of Olsen, *i.e.*, ***generating excitement and encouraging wagering by employing randomness to keep payout details a mystery to the players***. As *M.P.E.P.* § 2143.01 V. provides, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." In addition, *M.P.E.P.* § 2143.01 VI. explains that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." Indeed, as also described previously, Olsen actually teaches away from displaying the weighted payout table to the players. Any evidence of teaching away constitutes evidence of non-obviousness that must be considered. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978). Accordingly, the teachings of Piechowiak are not combinable with Olsen to establish a *prima facie* case of obviousness against the claims.

Furthermore, independent claim 16 recites "in response to receiving a wager-input signal from one of said plurality of gaming terminals, said controller allocating portions of said wager input among said progressive awards and sending an update pay-table signal to said plurality of gaming terminals to instruct said plurality of gaming terminals to update said corresponding progressive awards within said pay table." Similarly, independent claim 25 recites "apportioning said wager inputs from said plurality of sessions among said payout amounts for a majority of said winning outcomes of said basic wagering game being conducted at said plurality of gaming terminals so as to increase said payout amounts, said majority of said payout amounts providing a progressive award." Although Piechowiak may teach updating and displaying a pay table, neither Olsen nor Piechowiak teaches continuously updating a pay table to reflect changes in ***progressive awards based on portions of wager inputs from other gaming machines***, as generally required by the claims.

In particular, the Office Action asserts that the weighted payout table 294 in Olsen corresponds to the pay table recited in the claims. *See, e.g.*, Office Action, p. 5, lines 1-5. As shown in TABLE I of Olsen, the weighted payout table provides a payout and a corresponding weight, which is the frequency at which the payout is provided. *See* Olsen, col. 17, lines 28-46. Olsen fails to teach or suggest that any of the values provided in the weighted payout table are ever updated. Moreover, nothing in Olsen even indicates that the actual values in the weighted payout table are dependent on the wagers received. Indeed, as described previously, the Office Action concedes that “Olsen does not appear to teach update the payout amounts of the payable of each gaming machine based on portions of a wager input from other gaming machines as claimed.” Office Action, p. 5, lines 16-17.

Meanwhile, the Office Action also asserts that “Piechowiak teaches a system in which plural gaming machines under the control of a controller update or modify award/pay table amounts based on a feature enabled from polled game results from each gaming machine based at least on each players wagers.” Office Action, p. 6, lines 13-18. Although polled game results based on wagers may trigger a modification of a pay table in Piechowiak, Piechowiak fails to teach or suggest that portions of the wagers are actually applied to any progressive awards shown in the pay table. It is noted that the Office Action cites the use of a common bonus counter in the system of Piechowiak (*see* Office Action, p. 6, lines 17-18), but this common bonus counter is increased when a particular symbol combination is achieved and is not dependent on portions of wagers. *See* Piechowiak, col. 6, lines 22-26; col. 9, lines 26-43. Indeed, Piechowiak merely states that a bonus award is provided to the player who reaches the bonus counter threshold and fails to even suggest that this bonus award is based on portions of wagers. *See* Piechowiak, col. 9, lines 33-35.

Because neither Olsen nor Piechowiak discloses a pay table that is continuously updated to reflect changes in progressive awards based on portions of wager inputs, the applied references fail to teach or suggest each and every element of claims 16 and 25. One basic requirement for a *prima facie* case of obviousness under § 103(a) is that the prior art references must teach or suggest all of the claim limitations. M.P.E.P. § 2143. Thus, a *prima facie* case of obviousness cannot be established according to the teachings of Olsen and Piechowiak.

In view of the foregoing, the Office Action has failed to provide a *prima facie* case that the teachings of Olsen and Piechowiak can be combined to achieve the invention as recited in

claims 16 and 25. Accordingly, withdrawal of the rejection is in order and is respectfully requested. In addition, Applicant respectfully submits that dependent claims 17, 18, 27, 32, and 33 are allowable at least for the same reasons as base claims 16 and 25. The rejection of dependent claims 30 and 31 has been rendered moot by their cancellation.

Claims 19-24, 26, 28-29, and 34-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Olsen in view of Piechowiak, and further in view of U.S. Patent No. 5,851,149 to Xidos et al. Applicant respectfully submits that dependent claims 19-24, 26, 28-29, 34, and 35 are allowable at least for the same reasons as base claims 16 and 25 described previously. Accordingly, withdrawal of the rejection is in order and is respectfully requested.

### **Conclusion**

It is the Applicant's belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

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Respectfully submitted,

By: /Joey C. Yao/

Joey C. Yao  
Registration No.: 63,810  
NIXON PEABODY LLP  
161 N. Clark St., 48<sup>th</sup> Floor  
Chicago, Illinois 60601  
(312) 425-3900  
Attorneys For Applicant